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**OFFICE OF PETITIONS**

In re Application of	:	
Kovach	:	
Application No. 10/602,406	:	DECISION ON PETITION
Filed: 23 June, 2003	:	
Attorney Docket No. 16-343	:	

This is a decision on the petition filed on 29 April, 2005, as a request to withdraw the holding of abandonment, and so considered under 37 C.F.R. §1.181.

For the reasons set forth below the petition under 37 C.F.R. §1.181 is **GRANTED**.

**BACKGROUND**

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to a 12 August, 2004, non-final Office action with reply due absent extension of time on or before 12 November, 2004;
- the Office mailed a Notice of Abandonment on 15 April, 2005;
- Petitioner responded on 29 April, 2005, with, *inter alia*, (a) the instant petition; (b) a copy of an Amendment and Amendment transmittal bearing certificates of mailing of 12 November, 2004, and so constituting Petitioner's reply to the Office action; and (c) a date stamped receipt card evidencing Office receipt of the reply on 15 November, 2004.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

#### As to a Request to Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

of a holding of abandonment.<sup>7</sup> (See: the commentary set forth at MPEP §711.03(c).)

Petitioner has evidenced timely submission of a reply to the 12 August, 2004, non-final Office action.

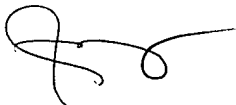
Thus, Petitioner has satisfied the showing required under Delgar and thus to be considered under the provisions of 37 C.F.R. §1.181.

### CONCLUSION

The petition(s) under 37 C.F.R. §1.181 is **granted**; fees are waived and none were charged, and the 5 April, 2005, Notice of Abandonment is **vacated**.

The instant file is released to Technology Center 3700 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).